

REMARKS

Claims 1-20 are pending. This includes independent claims 1, 14 and 18.

Claim 1 now stands rejected under 35 U.S.C. § 101 as drawn to non-statutory subject matter for failing to “transform underlying subject matter (such as an article or materials) to a different state or thing” or for not being “tied to another statutory class (such as a particular machine).”

The previous rejections of claims 1-8 and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Caro et al. '109 and further in view of Mullins '293 has been sustained.

Claims 14-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Penrice '514 and further in view of Caro et al. '109, and further in view of Mullins '293.

A. 35 U.S.C. § 101 Rejection of Claim 1

Applicant respectfully asserts that independent claim 1 is proper under Section 101 and the recent *Bilski* decision, as set forth below.

At least two recent Federal Circuit opinions provide useful guidance for analyzing process claims under 35 U.S.C. § 101: (1) *In re Comiskey*, 499 F.3d 1365, 84 U.S.P.Q.2d 1670 (Fed. Cir. 2007); and (2) *In re Bilski*, No. 2007-1130 (Fed. Cir. Oct. 30, 2008). *In re Comiskey* held that mental processes standing alone are not patentable, but that claims which under their broadest reasonable interpretation could require the use of a computer are patentable under 35 U.S.C. § 101. The patent application under consideration in *In re Comiskey* concerned a method and system for mandatory arbitration involving legal documents, such as wills or contracts. Some of the process

claims in *In re Comiskey* (i.e., method claims 1 and 32) were held to be unpatentable under 35 U.S.C. § 101 because they did not require a machine and allegedly sought to patent the use of human intelligence in and of itself. *Comiskey*, 499 F.3d at 1379. However, other independent claims (i.e., claims 17 and 46) required the use of a computer by referring to various “modules” and by requiring networked access to the Internet or other communications means. Since these latter claims, under their broadest reasonable interpretation, combined a mental process with a machine, the combination was held to produce patentable subject matter. *Id.* at 1379.

In re Bilski further clarified the law regarding patentability of process claims, by rejecting the prior “useful, concrete and tangible result” test and adopting the “machine-or-transformation test.” The new machine-or-transformation test finds patentable subject matter if a claim: (1) is tied to a particular machine or apparatus; or (2) transforms a particular article into a different state or thing. *In re Bilski*, Slip Opinion 2007-1130 at 10. “[T]he use of a specific machine or transformation of an article must impose meaningful limits on the claim’s scope to impart patent-eligibility” and “must not merely be insignificant extra-solution activity.” *Id.* at 24. Although the Federal Circuit provided additional insight into the transformation part of the test, it left to future cases the elaboration of the precise contours of machine implementation, as well as the answers to particular questions such as whether or when recitation of a computer suffices to tie a process claim to a particular machine. *Id.* at 24.

The gaming method respectively set forth in claim 1 of the present application relates to transformation of a particular article or thing into a different state and is inherently tied to an article for displaying the transformation. For example, claim 1 calls

for storing a plurality of instant win game display themes and for displaying one of these themes for play of the instant win game. Thus, multiple game themes are generated and stored, and subsequently displayed to a player. The “display” is obviously a visual display that is presented to the player and is a transformation of the stored display theme information into a visual display. In addition, the claim inherently requires some means to display the theme to the player, for example by printing the theme on a game ticket, and the like. Claim 1 further calls for displaying the outcome of the instant win game with one of the plurality of game themes in a manner that is identifiable to the player. Again, this requires transformation and configuration of the game indicia with one of a plurality of game themes in a visual display that is readily identifiable by the player.

Respectfully, the gaming method of claim 1 is more than a purely mental process, and requires the manipulation and transformation of data (game indicia and game themes) into a visual display for players to conduct the game. Claim 1 is drawn to patentable subject matter.

B. 35 U.S.C. §103(a) rejection of claims 14-20

The Examiner has wrongfully rejected Applicant's position that Penrice '514 is not a proper reference in an obviousness rejection of the present claims because the Assignment from the inventor was executed a month after the present application was filed.

Section 103(c) states: “... where the subject matter and the claimed invention, were, at the time the claimed invention was made, owned by the same person **or subject to an obligation of assignment to the same person....**” Mr. Robb was an

employee of the Assignee IGT and was under an obligation to assign his inventions to the company.

In addition, respectfully, Applicant is not required to supply forms or other evidentiary documents to prove common ownership. MPEP § 706.02(I)(2)(II) entitled "EVIDENCE REQUIRED TO ESTABLISH COMMON OWNERSHIP" addresses the applicant's burden of establishing common ownership to remove a reference under 35 USC § 103(c), and states:

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

The MPEP gives the following further guidance:

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

The example cited above is directly applicable to the present situation. A proper statement of common ownership from the attorney of record satisfies the applicant's

burden. Applicant is not required to supply forms or other evidence proving such ownership. Applicant in the present application has in good faith met the requirements set forth above, and even supplied the additional assignment records to supplement the statement of common ownership.

For sake of completeness, Applicant again sets forth the following:

Statement Concerning Common Ownership

The present application serial no. 10/670,555 and U.S. Pat. App. Serial No. 10/603,539 to Penrice were, at the time the invention of the present application was made, owned by or subject to an obligation of assignment to, IGT.

Thus, Penrice '514 is not a proper reference in a §103(a) rejection of any claim in the present application. Accordingly, the rejection of claims 14-20 based on Penrice '514 cannot stand, and applicant respectfully submits that these claims are allowable. Favorable action thereon is respectfully requested.

B. Rejection of Claims 1-13 under 35 U.S.C. § 103(a)

Applicant proposes to amend the independent claims to clearly set forth that the first and second sets of game indicia are the player's entries into the respective base wagering game and instant win game, ***and thus cannot possibly read on a set of randomly generated indicia that is compared to the player's entry in an instant win game, such as the set of indicia 30 in Caro '109.*** Applicant respectfully submits that the proposed amendments relate to issues already considered in great detail by the Examiner, and will not require additional search or work on the part of the Examiner.

At page 18 of the Final Office Action, the Examiner states:

Caro et al., in figure 2A disclosed below, clearly shows two distinct sets of indicia elements 26 & 30, which are independent of each other. In paragraphs 47-49,

Caro et al. further discloses of multiple indicia, wherein indicia one is used for an instant win game and indicia two is for lottery play. Thus, Caro et al. discloses of two distinct set of indicia.

Fig. 2a is a game ticket 12 that is printed and presented to the player after the player has wagered on the future lottery draw game and opted into the instant win game for an additional wager. The numbers 26 are the player's entry for the future lottery draw game, as clearly explained in Pars. 0042 through 0044. Par. 0045 describes that the visual indication 28 ("Yes") on the ticket 12 reflects that the player paid the additional wager amount required for the instant game. Fig. 2A is presented below:

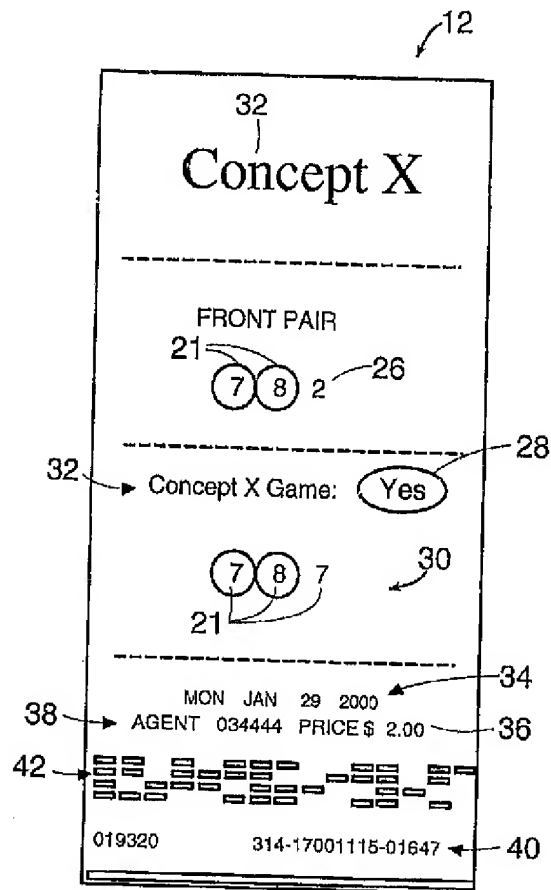


FIG. 2A

Par. 0048 of Caro '109 states:

Play of **both** the future draw and the instant lottery game, if selected, can use this one ticket 12. **Play of the instant game involves matching the player-selected numbers from the first set 26 with a like-type of numbers from the second set 30.** The second set 30 is produced from the available field of numbers by the random number generation 24.... The set 30 is stored in memory... and transmitted... to the given terminal 16. The sets 26 and 30 appearing on a given ticket 12 at a given terminal 16 are uniquely associated with that one play of the game.

There is no question that the second set of numbers 30 **are not the player's entry in the instant win game**, but are randomly generated numbers against which the player's entry 26 is compared.

Par. 0049 clearly explains that, regardless of the outcome of the instant game, "the player continues to have the opportunity to play, and possibly win, **the future lottery game. With the same player-selected set of numbers**, play is therefore extended, and play value of the game increased." In fact, Par. 0050 describes that, if the player turns in the ticket 12 to redeem the instant win game prize, a trailer ticket 14 may be issued to the player that includes information from the original ticket 12 necessary to play the future game:

In particular, **the trailer includes the same player-selected first set 26 of game pieces as used in the instant lottery game.** The trailer ticket can be like the original winning ticket [12], but without the second set 30 of the instant game.

There is thus no question that the player's selected numbers 26 **are the same set of numbers used in play of the future lottery draw game.**

Thus, Caro '109 expressly describes that the same set of indicia (numbers 26) are used as the player's entry in the instant game and the future lottery draw game. As previously explained, the very purpose of the game of Caro '109 is to use the same entry in both games so as to allow the player to have "multiple play opportunities with

his or her selected set of numbers." (Caro '109, paragraph 0022) Caro '109 expressly states that the purpose for using the same entry for both games is that:

With the same player-selected set of numbers, play is therefore extended, and play value of the game is increased. (Caro '109, paragraph 0049)

Respectfully, there is no reasonable interpretation of Caro '109 that falls within the present claims. Claim 1 calls for generating a first set of game indicia as the player's entry for the base wagering game, and a separate second set of game indicia that is different from the first set of game indicia as the player's entry in the instant win game. The claim further calls for determining and displaying an outcome of the instant win game for the player based on the second set of game indicia such that the instant win game is independent from the base wagering game entry and is not dependent upon or a function of the first set of game indicia. There is simply no reasonable interpretation of these claim limitations that would encompass an instant win game and a future game that use the same set of game indicia as the player's entry to each respective game, as in the game of Caro '109.

Independent claims 14 and 18 are amended herein in a manner similar to that set forth above with respect to claim 1, and the distinguishing remarks apply to these independent claims as well.

With respect to the independent claims, Mullins was cited merely as teaching a lottery game wherein the theme of the instant win game is completely different from the theme of a base game. Mullins may teach to have games with different themes, but there is nothing in Mullins that would result in one skilled in the art reconfiguring the game of Caro '109 such that a second set of game indicia is generated as the player's

entry to the instant win game that is different from the player's entry to the future lottery draw game, as discussed in detail above. This is particularly true when considering that the very purpose of Caro '109 is to provide the player with different play opportunities with the same set of game indicia.

Accordingly, applicant respectfully requests the Examiner to reconsider the obviousness rejection of the present claims in view of the base reference Caro '109, and to allow the claims.

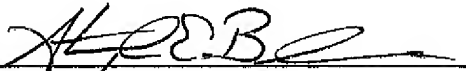
Claims 2 through 13 only further patentably define the method of claim 1, and are allowable for at least the reasons claim 1 is allowable.

As discussed above, claims 14 through 20 are allowable for at least the reasons that Penrice '514 is not a proper reference in the §103 rejection. In addition, independent claims 14 and 18 are amended herein to reflect the distinctions set forth and discussed above with respect to claim 1, and are additionally allowable for at least the reasons that claim is allowable.

With the present Amendment, applicant respectfully submits that all pending claims are allowable, and that the application is in condition for allowance. Favorable action thereon is respectfully requested. The Examiner is encouraged to contact the undersigned at his convenience should he have any questions regarding this matter or require any additional information. Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully submitted,

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